

15/87

R-1987-1

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re)	Decision on Petition
)	To Review a Final
Petitioner)	Decision of the
_____)	Director of Enrollment
		and Discipline

(hereinafter "petitioner")
petitions under 37 CFR 10.2(c) for review of a decision of the Director of the Office of Enrollment and Discipline (OED) denying petitioner's request to be admitted to practice before the Patent and Trademark Office (PTO). Petitioner took the afternoon section of the April 8, 1986 examination for registration; he had successfully taken the morning section previously. Petitioner received a grade of less than 70 points in the afternoon section; a score of at least 70 points is required for admission to practice. Petitioner asserts the following points I-VI in challenging the Director's decision (petitioner's wording):

I. Receiving less than three hours to write the afternoon examination on April 8, 1986, should not result in a loss of all 20 points for an incomplete answer to question 5.

II. OED violates PTO rules by inserting question 5, an ethics question, into the afternoon examination of April 8, 1986.

III. Questions 4 and 5 of the afternoon examination of April 8, 1986, bear arbitrarily inflated point-values when compared to the 100 questions posed in the morning examination.

IV. Questions 1, 2 and 3 of the afternoon examination of April 8, 1986, bear arbitrarily deflated point values when compared to questions 4 and 5.

V. Using two questions arbitrarily inflated to 40% of the afternoon examination transforms the grade into an invalid indicator of the candidate's ability to practice before the PTO.

VI. My answers to questions 4 and 5 of the afternoon examination on April 8, 1986, were misgraded.

Petitioner prays for the following relief: a hearing regarding this petition; prompt addition of his name to the register of attorneys; reversal of OED's denial of registration; and a refund of the \$250.00 examination fee sent to OED in July of 1986 in support of his application for the October 1986 registration examination.

Petitioner's points are considered seriatim as follows.

I. Petitioner has shown no error in the Director's decision to sustain the grader's deduction of the full 20 points for question 5. The record fully supports the Director's analysis of petitioner's allegation that two minutes less than the full 3 hours were given to complete the afternoon section of the examination. The Director noted that petitioner's partial answer to question 5 did not respond to the question. The first sentence of the answer in fact is in direct conflict with the requirement in the question to avoid further dealings with the client.

II. It is not a violation of PTO rules for an ethics question, question 5, to have been included in the afternoon section of the examination. No PTO rule limits ethics questions to the morning section or prohibits them in the afternoon section. The following statement which you quote from the "General Requirements for Admission to the Examination for Registration to Practice * * *" (July 1985) does not support your position:

The morning section of the examination will ordinarily include questions dealing with standards of ethical and professional conduct applicable to registered patent attorneys and agents.

The word "ordinarily" cannot be read out of the statement.

III. The Director correctly held that petitioner's comparison of the morning and afternoon sections with regard to the weight which should be given to the questions in the afternoon section is without merit. As the Director indicated, questions 4 and 5 of the afternoon section involved much more than simply copying a regulation as petitioner contends.

IV & V. The Director correctly upheld the scoring of the afternoon section on the grounds that each of the 5 questions "was deemed equally complex," and that the matters considered in questions 4 and 5 are "just as important" as the description and differentiation of inventions (questions 1, 2, 3). The questions themselves do not bear out petitioner's assertion of a distinction between questions 1, 2, and 3 on the one hand and questions 4 and 5 on the other hand on the basis that correct answers to questions 1, 2, and 3, unlike the answers to questions 4 and 5, could not be found in the statutes, regulations, and other materials a candidate might bring to the examination.

VI. The Director fully considered and correctly sustained the grading of questions 4 and 5. Contrary to petitioner's contentions, the wording of question 4 simply does not lend itself to any correct interpretation other than that of the Director. Moreover, as the Director pointed out, questions 4 and 5 were not designed solely to test for writing skills but also to test for knowledge and understanding of PTO rules and procedures and the ability to explain their application to a factual situation in essay form.

Since your petition fails to provide any basis for revising the Director's decision refusing to grant your request for a passing grade, the Director's decision is affirmed.

Your request for an oral hearing is denied since it has not been found necessary for consideration of the questions raised in your petition. See 37 CFR § 10.2(c), last sentence.

The denial by OED of your request for refund of the \$250.00 fee submitted in July 1986 is affirmed. The record shows that the fee was submitted with your application to take the afternoon section of the October 14, 1986, examination. By letter dated October 3, 1986, you returned the admission card for the October 14 examination, stated you had no reason to take the examination and requested reimbursement of the fee. On November 11, 1986, the Director of OED denied reimbursement on the ground the fee was not paid by mistake. The Director's ruling is clearly in accordance with 35 U.S.C. § 42(d) which provides that the Commissioner's authority to make refunds is limited to "any fee paid by mistake or in excess of that required." Moreover, since you obviously changed your mind after applying to take the October examination, the Director's ruling is clearly supported by 37 CFR § 1.26(a) which

precludes a refund because of "a mere change of purpose after the payment of money, as when a party desires to withdraw an application."

The petition is denied.

Dated:

Jan 15, 1987

Donald W. Peterson

DONALD W. PETERSON

Deputy Commissioner of
Patents and Trademarks

cc: